

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

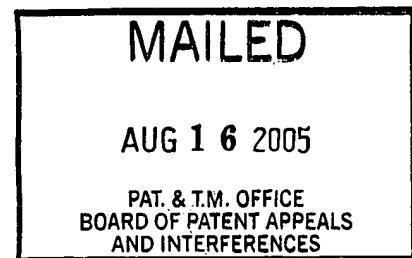
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MATTHEW P.J. BAKER, TIMOTHY J. MOULSLEY
and BERNARD HUNT

Appeal No. 2005-1688
Application No. 09/478,467

ON BRIEF



Before HAIRSTON, SAADAT, and MACDONALD, **Administrative Patent Judges**.

MACDONALD, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 13-29.

Claims 1-12 have been cancelled.

Invention

Appellants' invention relates to a radio communication system, primary station, secondary station, and method with a communication channel between a primary station and a secondary station, the channel comprising an uplink and a downlink control channel for transmission of control information, and a data channel for the transmission of data, wherein power control means are provided

for adjusting the power of the control and data channels and means are provided for delaying the initial transmission of the data channel until after the initial transmission of the control channels. Appellants' specification at page 2, lines 11-19.

Claim 13 is representative of the claimed invention and is reproduced as follows:

13. A radio communication system, comprising:

 a secondary station for transmitting a request for resources;
 a primary station for transmitting an acknowledgement of the request for resources;

 wherein, subsequent to a reception of the acknowledgement by said secondary station, control information is initially transmitted on an uplink control channel and a downlink control channel between said primary station and said secondary station;

 wherein, subsequent to the reception of the acknowledgement by said secondary station, data is initially transmitted on an uplink data channel from said secondary station to said primary station; and

 wherein the initial transmission of data on the uplink data channel is determinedly delayed until after the initial transmission of control information on the uplink control channel and the downlink control channel.

References

The references relied on by the Examiner are as follows:

Esmailzadeh et al. (Esmailzadeh)	6,175,744	Jan. 16, 2001 (Filed Nov. 28, 1997)
Mustajarvi	6,356,759	Mar. 12, 2002 (\$102(e) date Nov. 27, 1998)

Rejections At Issue¹

Claims 13, 16-19, 22-23, and 26-27 stand rejected under 35 U.S.C. § 102 as being anticipated by Mustajarvi.

Claims 14-15, 20-21, 24-25, and 28-29 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Mustajarvi and Esmailzadeh.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.²

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 13, 16-19, 22-23, and 26-27 under 35 U.S.C. § 102, and we reverse the Examiner's rejection of claims 14-15, 20-21, 24-25, and 28-29 under 35 U.S.C. § 103.

Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the brief have not been considered. We deem such

¹ Despite references to other rejections in the brief at page 5, and to different groupings of the claims with the two grounds of rejection in the answer at page 3, we find the rejections to be as listed herein based on the discussion of the grounds of rejection found in the action mailed September 20, 2003.

² Appellants filed an appeal brief on May 6, 2004. Appellants filed a reply brief on September 27, 2004. The Examiner mailed an Examiner's Answer on July 26, 2004.

arguments to be waived by Appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

I. *Whether the Rejection of Claims 13, 16-19, 22-23, and 26-27 Under 35 U.S.C. §102 is proper?*

It is our view, after consideration of the record before us, that the disclosure of Mustajarvi does not fully meet the invention as recited in claims 13, 16-19, 22-23, and 26-27. Accordingly, we reverse. For purposes of our discussion, we will treat claim 13 as a representative claim of claims 13, 16-19, 22-23, and 26-27.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 13, Appellants argue at the first paragraph of page 11 of the brief, “*Mustajarvi fails to disclose . . . [an initial] transmission of the control information subsequent to a reception of an acknowledgement by secondary station MS.*” In the answer at pages 4-5, the Examiner counters by arguing that the disclosed invention includes control information in the acknowledgement, therefore the claim must be read as such (despite the explicit language “initially transmitted” in line 5 of claim 13). The Examiner supports this reading of the claim by quoting from Appellants’

specification at pages 6 and 7. We have reviewed the specification at the lines cited by the Examiner and do not find the quoted language. Rather, the quoted language is found in Appellants' description of the prior art at page 5, lines 3-7 and 27-30. Consequently, we see no basis for the Examiner's interpretation of claim 13. The Examiner has not established why Appellants' acknowledgement must be read to include control information in contradiction to the explicit language of the claim. Further, if such a basis exists, it does not warrant ignoring the explicit language of the claim. Rather, if the language of a claim is not supported by the specification, then it raises issues under 35 U.S.C. § 112.

Therefore, we find that the Examiner has not met the initial burden of establishing a ***prima facie*** case of anticipation, and we will not sustain the Examiner's rejection under 35 U.S.C. § 102.

II. Whether the Rejection of Claims 14-15, 20-21, 24-25, and 28-29 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 14-15, 20-21, 24-25, and 28-29. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a ***prima facie*** case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The

Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. “In reviewing the [E]xaminer’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.” *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. “[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.” *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to dependent claims 14-15, 20-21, 24-25, and 28-29, we note that the Examiner has relied on the Esmailzadeh reference solely to teach control channel features. The Esmailzadeh reference in combination with Mustajarvi fails to cure the deficiencies of Mustajarvi noted above with respect to claim 13.

Therefore, we will not sustain the Examiner’s rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

Conclusion

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. §102 of claims 13, 16-19, 22-23, and 26-27; and we have not sustained the rejection under 35 U.S.C. §103 of claims 14-15, 20-21, 24-25, and 28-29.

REVERSED



KENNETH W. HARSTON
Administrative Patent Judge



MAHSHID D. SAADAT
Administrative Patent Judge

) BOARD OF PATENT
APPEALS AND
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ALLEN R. MACDONALD
Administrative Patent Judge

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